

**REMARKS**

This Amendment is in response to the Final Office Action mailed July 9, 2008. Claims 1, 4, 5, 8-13, 16, 17, 20-25, 28, 29, 32-36 and 44-52 are pending. In this response, claims 1, 13, and 25 have been amended. No claims have been added or cancelled. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

***Rejection Under 35 U.S.C. § 103***

The Examiner rejects claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35, and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Morris et al. (U.S. Patent 5,420,974) in view of Schena et al. (U.S. Patent 6,448,979). Applicants respectfully disagree.

Morris describes a document that is divided into two types of fields. A first field type of the document displays text and images, and a second field type of the document displays check boxes (Morris, column 1, line 58 to column 2, line 9). When a check box field is checked, non-visual content (audio, video, or animation not displayed in the document) for the document is available. During creation of a document, if a checked box for a second field type is selected by a user, a dialog box prompts the user to specify an address for the audio or video content (Morris, column 2, line 61 to column 3, line 4). A pointer is created for the content so that when a user selects a checked box in a document, the content may be accessed from storage via the pointer (Morris, column 3, lines 4-27).

Schena describes a system in which a bar code is read from a printed medium (Schena, column 1, line 61 to column 2, line 25). The bar code contains link information to corresponding multimedia sequence information, such as advertising, transaction information, text information, etc. (Schena, column 2, lines 13-25; column 3, line 58 to column 4, line 5). A scanner that detects the barcode routes the link information to a server, which selects information

corresponding to the received link from a remote content provider (Schena, column 2, lines 29-54).

Claim 1 recites:

A method comprising:  
creating a multimedia annotation for a paper document, the multimedia annotation representing at least an audio sound and a video clip; and  
creating a first multimedia document by combining the paper document and the multimedia annotation represented by a first bar code encoding the audio sound and video clip,  
wherein the first multimedia document is generated as a part of reproducing the paper document via a document reproduction system, wherein the multimedia annotation is captured via an input device of the document reproduction system while the paper document is being reproduced via the document reproduction system, wherein the captured multimedia annotation is encoded within the first bar code, and  
wherein the first multimedia document, which when scanned by a process, the process causes the printed multimedia annotation to be decoded, the audio sound and video clip to be extracted from the multimedia annotation, and the extracted audio sound and video clip can be played via a multimedia player, wherein the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document.

(Emphasis Added)

That is, in accordance with claim 1, an audio and video clip, captured via an input device of a document reproduction system, are encoded in a bar code. The bar code can be printed on a multimedia document, when the multimedia document is generated by the document reproduction system, such as a scanner or copier. The multimedia document includes the bar code encoding the audio sound and video clip which can be subsequently scanned and decoded to extract the audio sound and video clip from the barcode. The audio sound and video clip extracted and decoded from the barcode can then be played by a multimedia player, where the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document.

Applicants respectfully submit that neither Morris nor Schena, alone or in combination, describe or suggest that the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document.

Morris describes a form with user selectable check boxes, where content associated with a check box may be accessed from storage via a pointer (Morris, column 6, lines 18-40; Figure 1). Schena describes a form that links content to remote provider servers (Schena, column 4, lines 7-31; Figures 1-4). Thus, both Morris and Schena require accessing storage external to a document to obtain audio and visual data (e.g., an MODCA envelop directory in Morris at column 2, lines 24-40, and remote content providers in Schena at column 1, lines 10-25). Thus, both references describe the opposite of that claimed by the Applicants, where the audio sound and video clip extracted and decoded from the barcode can then be played by a multimedia player, and the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document.

Therefore, a combination of Morris and Schena must fail to teach or suggest “the audio sound and video clip to be extracted from the multimedia annotation, and the extracted audio sound and video clip can be played via a multimedia player, wherein the audio sound can be extracted directly from the first bar code without having to access resources outside of the first multimedia document,” as claimed. Thus, Morris and Schena fail render claim 1, and the claims that depend on it, obvious.

Because claims 13 and 25 include limitations similar to those discussed above with respect to claim 1, claims 13 and 25 are similarly not anticipated by Morris and Schena. Given the remaining claims depend from one of the above independent claims, for reasons similar to

those set forth above, it is respectfully submitted that the rest of the claims are also patentable over a combination of Morris and Schena.

Applicant respectfully requests that the Examiner withdraw the rejections of claims 1, 4-5, 8-11, 13, 16-17, 20-23, 25, 28-29, 32-35, and 44-52 under 35 U.S.C. § 103(a) as being unpatentable over Morris, in view of Schena.

The Examiner rejects claims 12, 24 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Morris, in view of Schena, and further in view of Halliday et al. (U.S. Patent 5,880,740). Applicants respectfully disagree.

Claims 12, 24, and 36 depend from one of the above independent claims. It is respectfully submitted that Halliday also fails to disclose the limitations set forth above. Therefore, for reasons similar to those set forth above, it is respectfully submitted that claims 12, 24, and 36 are also patentable over a combination of Morris, Schena, and Halliday. Withdrawal of the rejections is respectfully requested.

***Conclusion***

Applicant reserves all rights with respect to the applicability of the doctrine of equivalents. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 720-8300.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: September 9, 2008

By

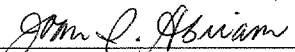
  
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 9/9/2008  
Joan I. Abriam September 9, 2008